

Remarks

Status of Claims:

Claims 1-7, 21-34 stand rejected. Claims 1 and 7 are amended. Claim 4 is canceled. Claims 1, 5-7, and 21-34 remain pending.

Claim 1 is amended to recite at least two electrodes. No new matter is added.

The claim amendments are made without prejudice to applicant filing one or more continuation applications with claims as originally filed or previously presented.

§ 103 Rejections:

Claims 1, 4-6, and 34 are rejected as obvious over Wardle et al. US2002/0120211 (Wardle) and Truckai (6,485,436). This rejection should be withdrawn for at least the following reasons.

First, the Examiner has not provided motivation in the prior art to combine Wardle and Truckai. The Examiner's only explanation for combining the references is that, according to the Examiner, Truckai provides an "analogous biopsy device", so that, per the Examiner's rejection, it would have been obvious to modify Wardle such that at least one of Wardle's electrodes is disposed on a sleeve in the manner recited in Claim 1.

This is no more than improper hindsight reconstruction of the Applicant's invention. It is respectfully urged that the Examiner does not meet the Examiner's burden of providing motivation for a prima facie case of obviousness by merely stating a feature is in one patent, and then concluding it would be obvious to modify another patent to have that feature. Using this standard, any two patents could be combined in any fashion imaginable by the Examiner.

Second, it is respectfully urged that one would also not modify Wardle as suggested by the Examiner, because it would be counter to the very teachings of Wardle. Wardle teaches that cutter 20 is “a distal tip cutter 20”, and that the distal tip cutter 20 is used to open a path through which the distal portion 18 of shaft 14 of Wardle’s device may be inserted. See first sentence of para 0030 of Wardle:

Distal tip cutter 20 has a cutting surface effective to cut through tissue, opening up a path through which distal portion 18 of shaft 14 may be inserted, thus aiding in the placement of shaft 14 within a patient’s body. Italics added.

Accordingly, one would not be motivated to move the cutter 20 to have the position suggested by the Examiner, because such a change in design would defeat the very purpose Wardle seeks to accomplish with a distal cutter.

The Examiner acknowledges that Wardle doesn’t teach an electrode disposed such that a portion of the electrode is disposed proximally of the distal most portion of the tissue receiving opening, and wherein at least a portion of the electrode is positioned distally of a proximal most portion of the tissue receiving opening, and the modification suggested by the Examiner is not supported by the art cited by the Examiner.

Withdrawal of rejection of Claims 1, 5-6, and 34 is requested.

Claims 21-25, and 27-33 are rejected as obvious over Wardle in view of Shadduck (6,740082). It is respectfully urged this rejection is improper for at least the following reasons.

It is respectfully urged that one would not modify Wardle for at least the reason (as noted above) Accordingly, withdrawal of the rejection is requested.

In particular, Shadduck shows the electrodes 45 spaced away from the tip 16 of Shadduck. It is respectfully urged that if anything, Shadduck teaches away from the purpose of Wardle of having a distal tip cutter. If one placed the cutter 20 of Wardle as suggested by Shadduck, the

cutter 20 would not be in a position to perform the very operation for which Wardle provides cutter 20... -- *opening up a path* through which distal portion 18 of Wardle's shaft 14 may be inserted.

The arguments made in prior responses are maintained, in addition to those arguments included in this response.

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance.

Respectfully submitted,

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